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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,053	01/29/1999	CLEMENT W. BOWMAN	PROGRID	6857
22191 7590 05/03/2007 GREENBERG TRAUIG, LLP 1750 TYSONS BOULEVARD, 12TH FLOOR MCLEAN, VA 22102				
			EXAMINER BLECK, CAROLYN M	
			ART UNIT 3626	PAPER NUMBER
			NOTIFICATION DATE 05/03/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kinneyb@gtlaw.com  
goepelj@gtlaw.com  
feronys@gtlaw.com

**Office Action Summary**

Application No.

09/240,053

Applicant(s)

BOWMAN, CLEMENT W.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the response filed on 2/16/07.

Claims 1-20 are pending.

### ***Requirement for Information Under 37 C.F.R. § 1.105***

2. Applicant's reply to the Requirement for Information is sufficient.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to the claim limitation "establishing a first independent variable and a second independent variable...", Applicant has provided various portions of the specification to comply with the enablement requirement. The Examiner respectfully submits that page 6, line 18 through page 7, line 15, page 7, lines 14-15, and Figures 1a-1d, 4a-4b, 5, 6, 8, 10, 11, and 12 as examples of

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independent variables. However, these are examples of independent variables. Applicant has failed to describe how to "establish a first independent variable and a second independent variable related to the value of said specific intangible asset of interest" in the specification in such a way as to enable one skilled. How would one skilled in the art know which independent variables should be established? There is no description of how this is done other than by providing examples.

With respect to the claim limitation "establishing a series of performance criteria statements probative of the value of said first and second independent variables," Applicant has provided various portions of the specification to comply with the enablement requirement. The Examiner respectfully submits that page 7, line 10 to page 10, line 5 and Figure 2 as examples of how to establish performance criteria statements. The Examiner respectfully submits that at page 8 of Applicant's specification states "The performance criteria can be defined by persons with extensive experience in the type of organization or asset being evaluated, or can be selected from a data base of previously-established matrices for similar organizations." Applicant has failed to provide support to enable "establishing a series of performance criteria statements" other than to state that a human could select them or that a database could be used. But it remains unclear how a human would know what a series of performance criteria statements probative of the value of said first and second independent variables. Applicant has provided no guidance as to how someone would do this. As such, Applicant has failed to describe the claimed limitation in the specification in such

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a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to the claim limitation "scoring each of said performance criteria statements," Applicant has provided various portions of the specification to comply with the enablement requirement. The Examiner respectfully submits that these portions of the specification do not teach "scoring each of said performance criteria statements" which Applicant describes at page 10 as being done by an evaluator. The evaluator's results are compiled and put into a form as shown in Figure 3. The issue remains as to how an evaluator scores each of said performance criteria statements other than randomly selected the statement that he think best describes the organization or asset being evaluated. Applicant has failed to describe the scoring of said performance criteria statements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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(A) The basis for the rejection of claims 1-20 under 35 U.S.C. 101 in the previous Office Action was that the claims do not produce a concrete result. Applicant argues that the claimed invention is not directed towards cold fusion, and therefore satisfies the requirement for providing a concrete result. *See In re Swartz*, 232 F. 3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where the result is not repeatable and unpredictable).

Applicant's claimed invention fails to provide a concrete result because it is not reproducible. Claim 1 recites "establishing a first independent variable and a second independent variable..." and "establishing a series of performance criteria statements...". Applicant provides an example of these steps based on Applicant's specification. These steps are performed by a user who establishes both the variables and the performance criteria. These steps fail to recite any objective means, steps or guidelines for how a user is to determine the independent variables and the performance criteria. Each time a user establishes the variables and performance criteria, different steps could be taken by the user. Furthermore, claim 1 recites "scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest." Applicant's specification describes this step at page 10. "An evaluator... selects (e.g., by circling) for each of the criteria the one statement which best describes the organization or asset being evaluated." This step of scoring does not provide any objective means or steps to score the performance

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criteria statements. Each time an evaluator "scores" the performance statements different steps could be taken.

Thus, each time a chart is plotted it will be different depending on the subjective input of a user. Each time a user goes through the method, they could chose different independent variables, performance criteria, and scoring for the same intangible asset. Thus, the result would be different each time the method is performed. This is not a concrete result because it is not repeatable or predictable. Thus, while claim 1 produces a tangible and useful result, claim 1 fails to produce a concrete result.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


**8. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

  
**Carolyn M. Bleck**  
**Patent Examiner**  
**Art Unit 3626**

**4/29/07**